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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 5577-322

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on September 13, 2006

Signature: /Erin A. Campion/

Typed or printed name: Erin A. Campion

Application Number	Filed
09/954,951	Sept. 18, 2001

First Named Inventor: John R. Hind

Art Unit	Examiner
2176	Robert Stevens

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 48,568
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Elizabeth A. Stanek/
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Telephone number

September 13, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[X] *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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Attorney's Docket No. 5577-322/RSW920010128US1 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Hind *et al.*
Serial No.: 09/954,951
Filed: September 18, 2001
Confirmation No.: 8532
Group No.: 2176
Examiner: Robert Stevens
For: **LOW-LATENCY, INCREMENTAL RENDERING IN A CONTENT FRAMEWORK**

Date: September 13, 2006

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Commissioner for Patents
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Alexandria, VA 22313-1450

CERTIFICATION OF ELECTRONIC TRANSMISSION UNDER 37 CFR § 1.8

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Erin A. Campion

REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. § 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which was extended until further notice on January 10, 2006.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefore. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 09-0461.

REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Action mailed June 13, 2006 (hereinafter "Final Action"). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Claims 1-7, 10-16, 24-29, 32-33, 35, 42-44 and 46-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Publication No. 2001/0034771 to Hutsch (hereinafter "Hutsch") in view of *HTML's META-tag: HTTP-EQUIV* by Alan Richmond

(hereinafter "Richmond"). *See* Final Action, page 2. Claims 8-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hutsch in view of Richmond in further view of United States Patent No. 6,453,361 to Morris (hereinafter "Morris"). Claims 17-22, 30-31, 34, 36-40, 45 and 50-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hutsch in view of Richmond in further view of *SAMS Teach Yourself Web Publishing with HTML 4 in 21 Days, 2nd Edition* by Laura LeMay (hereinafter "LeMay"). Claims 23 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hutsch in view of Richmond in further view United States Patent Publication No. 2002/0026500 to Kanefsky *et al.* (hereinafter "Kanefsky"). *See* Final Action, pages 12 and 15. Applicants respectfully submit that many of the recitations of the pending claims are not met by the cited references for at least the reasons discussed herein and in Applicants' previously filed Request for Reconsideration of March 23, 2006 and that the Final Action of December 23, 2005 (hereinafter "the First Action") and the Final Action (collectively "the Actions") fail to show that the recitations of the pending claims are obvious in view of the cited references. Therefore, Applicants respectfully request review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicants will only discuss the recitations of the independent Claim 1.

Independent Claim 1 recites:

> A method of incrementally rendering content in a content framework, comprising:
> receiving a request for a portal page, wherein one or more portlets provide content for the portal page;
> **immediately returning a response message containing a first document, the first document representing results from portlets which have acquired their content; and**
> **programmatically generating a mechanism for delivering an updated document if the first document does not represent results of all portlets.**

Claims 32 and 46 contain corresponding system and computer program product recitations, respectively. Applicants respectfully submit that at least the highlighted recitations of Claim 1 are neither disclosed nor suggested by the cited combination for at least the reasons discussed herein.

As discussed in Hutsch:

> [0100] Hence, upon retrieving the requested content using the handle provided by UCB 113, **web-top manager 111 loads, for example, a template and fills in all user specific content in the template using the retrieved content**. **The completed template is transmitted to client device 102i for display**. Alternatively, web-top manager 111 retrieves a stylesheet and uses the stylesheet to transform the content into a format that can be displayed on client device 102i.

See Hutsch, paragraph 100. In other words, the cited portion of Hutsch discusses loading a template with content and providing "the completed template" to the client device. Thus, all the information is gathered and then the "completed template" is transmitted to the client device. In contrast, Claim 1 recites receiving a request for a portal page and **immediately returning** a first document representing results from portlets which have acquired their content. Thus, according to some embodiments of the present invention, the first document is returned immediately **before all the information is gathered**, *i.e.*, before all the portlets have acquired their content. Accordingly, nothing in the cited portion of Hutsch discloses or suggests the immediately returning step of Claim 1 for at least the reasons discussed above.

Responsive to Applicants' argument set out above, the Final Action states that the "before all the information is gathered" and "determination of whether the first document represents the results of all the portlets... does not appear in the claims." *See* Final Action, page 17. Applicants' respectfully submit that Applicants clearly stated that "in some embodiments of the present invention...before all the information is gathered." Thus, Applicants never contended that this language was found in the claims. Furthermore, Claim 1 recites "programmatically generating a mechanism for delivering an updated document if the first document does not represent results of all portlets." *See* Final Action, page 17. Applicants respectfully submit that the determination of whether the first document does not represent results of all portlets is implicit in the "if clause."

The Final Action further states that the if clause in "**if** the first document does not represent results of all portlets" as recited in Claim 1 renders the subject of the clause optional (*See* Final Action, page 3 and Response to Arguments, page 17). Applicant respectfully submit that the "if clause" implies that it is determined whether the document represents the results of all portlets and **if** it does not, a mechanism for generating an updated document is programmatically generated as discussed above. Nothing in Hutsch discloses or suggests at least these recitations

of Claim 1. For example, as discussed in the cited portion of Hutsch (paragraphs 127-128), Hutsch discusses the use of JAVA beans and dynamically generated pages. Nothing in the cited portion of Hutsch discloses or suggests the determination of whether the first document represents results of the all portlets as recited in Claim 1. Thus, Claim 1 is patentable over Hutsch for at least these additional reasons.

The Final Action admits that Hutsch does not explicitly disclose "programmatically generating a mechanism for delivering an updated document" as recited in Claim 1. *See* Final Action, page 3. However, the Final Action points to Richmond as providing the missing teachings. *See* Final Action, page 5. Applicants respectfully disagree. The cited portion of Richmond discusses a META tag "that can be used by caches to determine when to fetch a fresh copy of the associated document." *See* Richmond, page 1. In other words, the data may be updated when the timer expires. In contrast, Claim 1 recites "programmatically generating a mechanism for delivering an updated document if the first document does not represent results of all portlets." In other words, according to some embodiments of the present invention, an updated document may be generated **if** the document does not include all of the portlets. Nothing in the cited portion of Richmond discloses or suggests the programmatically generating step of Claim 1 for at least the reasons discussed herein.

Accordingly, none of the cited references either alone or in combination disclose or suggest many of the recitations of Claim 1 set out above. Furthermore, there is no motivation or suggestion to combine the cited references as suggested in the Final Action. As affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. *See In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

The Final Action states:

> It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Richmond for the benefit of Hutsch, because to do so would allow a programmer to automatically refresh a document as taught by Richmond in p. 1, middle of page discussing the HTTP-EQUIV = "Expires" attribute. These

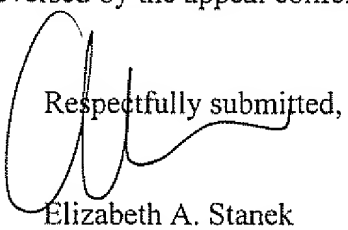
> references were all applicable to the same field of endeavor, i.e., web pages/service design.

See Final Action, pages 3-4. This motivation is a motivation based on "subjective belief and unknown authority", the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. In other words, the Final Action does not point to any specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Final Action. If the motivation provided in the Final Action is adequate to sustain the Office's burden of motivation, then anything in the "same field of endeavor" would render a combination obvious. This cannot be the case. Accordingly, the statement in the Final Action with respect to motivation does not adequately address the issue of motivation to combine as discussed in *In re Sang-su Lee*. Thus, it appears that the Final Action gains its alleged impetus or suggestion to combine the cited references by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references.

Furthermore, even if Hutsch and Richmond could be properly combined, the combination of Hutsch and Richmond would teach loading a template with content and providing "the completed template" to the client device, the completed template having the capability of being refreshed upon expiration of a timer. Accordingly, even if the cited referenced could be properly combined, the cited combination fails to disclose or suggest the recitations of Claim 1.

Accordingly, for at least the reasons discussed above, Applicants respectfully request that the present application be reviewed and reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,



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